UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>07 January 2011</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-21 and 23-30</u> is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-21 and 23-30</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Notice to Applicant

[1]   This communication is in response to the amendment filed 7 January 2011. The

Information Disclosure Statement (IDS) filed 10 January 2011 has been entered and considered.

Claim 22 has been cancelled. Claims 1 and 29 have been amended. Claims 1-21 and 23-30 are

pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

[2]   Claims 1-21 and 23-30 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Independent claims 1, 15, 25, and 29 have been amended with respect to the functions performed

by the recited filtering module to further specify "…determining information about the user

based on the user's historical access pattern to particular products or policies and services the

user in authorized to sell based at least in part on an IP address associated with the user...". In

particular reference to the amended limitation, it is unclear as to what in particular the modifying

statement "...based at least in part on an IP address associated with the user....". As structure the

noted "based on" modifier is reasonably interpreted as referring to any of the "determining

information" or the retrieved "products or policies" or the "authorized to sell" products. For

purposes of applying art, Examiner assumes the individual is identified in some manner based on

a network or IP address and the retrieved products are returned to the person based on the

address. However, this is not clear from the claim as presented and appropriate

clarification/correction is required.

NOTE for Applicant's benefit: Amendments to clearly indicate that the authorizations for

selling the products are based on the users IP address and that the specifically identified products

are determined and retrieved based on the users IP address could serve to distinguish the claimed

invention from the art of record. Applicant is encouraged to contact Examiner to discuss possible

amendments.

Dependent claims 2-14, 16-21, 23-24, 26-28, and 30 inherit and fail to remedy the deficiencies of

their respective independent claims and are also rejected under 35 U.S.C. 112, second paragraph,

as being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

Claim Rejections - 35 USC § 101

5 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

[3]   Previous rejection(s) of claims 1-14, and 29-30 under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory software per se have been overcome by the amendments to the subject claims and are hereby withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

[4]   Claims 1-2, 4-7, 9-21, 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Cullen et al., (United States Patent #6,272,528) in view of Herz et al. (United States Patent

#5,835,087) and further in view of Jinnett (United States Patent Application Publication

(#20020120477).

As per (currently amended) claim 1, Cullen et al. disclose a system for personalizing and

delivering insurance or financial services-related content to a user, comprising: a product or

service selection module for selecting at least one insurance or financial services-related category

or products or services the user is interested in (Cullen et al.; col. 5, lines 19-41 and col. 7, lines

16-67); a filtering module associated with an engine for (1) determining information about the

user based on the interest in particular insurance products or policies (Cullen et al.; col. 1, lines

31-45, col. 3, lines 29-34, and col. 5, lines 55-67), and (2) for personalizing and delivering the

insurance or financial services-related content based on the information about the user

(Cullen et al.; col. 1, lines 61-67, col. 6, lines 9-21, and col. 7, lines 16-67), the engine being

accessible to the user over a communications network (Cullen et al.; Abstract, col. 3, lines 2-9,
and col. 4, lines 1-35).

Cullen et al. fail to specifically indicate that the user's interest is "…..based on the user's
historical access pattern to particular insurance products or policies…" or that the products
retrieved are "products or services the user in authorized to sell…".

With respect to these features, Cullen et al. teach the use of mobile agents that gather user
information and preferences and subsequently collect information regarding insurance and
financial products that is filtered to reflect the expressed interests of the user, Cullen et al. fail to
disclose that user information and preferences are obtained via filtering the user's access
behavior with regard to specific subjects or products that are of interest to the user. The user
preferences are manually entered by an individual and retained by a "preferences agent".

Examiner notes that the claim as presently constructed recites an "engine" and then indicates an
intended use for the engine which includes using user information to search for "products and
services the user is authorized to sell" and "personalizing and delivering…at least one…insurance
or product the user is authorized to sell…". Examiner submits that under the broadest reasonable
interpretation of the above noted limitations, the agent-based search engine of Cullen et al.
retrieves information from a stored profile which is used repeatedly each time a search is
performed and thus retrieves information based on the same or slightly modified user profile
information each time (i.e., based on a historical access pattern). With respect to "user is

authorized to sell" Examiner submits that any search engine (e.g. Cullen et al.) when used by an individual searching for products they can sell (e.g. an insurance agent searching the employer insurance company's web content) would be aware of the companies with which the individual has a selling agreement and would use appropriate search terms to find "products the user is authorized to sell".

With respect to the "determining information" functions to further define the "user's historical access pattern" as "one or more products or policies that the user was interested in during a previous access to the system...", Cullen et al. fail to disclose filtering the historical access to products and services.

With respect to filtering an individual's access patterns to particular products and services, as is evidenced by Herz et al., filtering a user's browsing behavior, i.e., "access patterns" to generate an interest profile for the user that can be used to estimate the user's interest regarding other published material, is well-known in the electronic commerce and insurance/financial services art (Herz et al.; Abstract, col. 7, lines 47-67 and col. 17, lines 15-36).

With respect to the above noted limitation, Examiner respectfully submits that the filtering content of Herz et al., which is in accordance with an interest profile, is based on "...one or more products or policies that the user expressed interest in during a previous access to the system..." at least insofar as presently claimed. Specifically, Herz et al. disclose assembly of an interest profile that is generated and improved over time based on articles accessed by the user (Herz;

col. 7, lines 25-40, col. 58, lines 26-67, col. 59, lines 1-38). Examiner respectfully submits that

the noted teachings indicate that the information delivery of Herz is directly related to

information previously of interest to the user (see monitoring accessing of articles and updating

profile). With specific reference to the amendment to specify "expressed interest", Examiner

submits that the user profile is determined based on the articles/information the user opened a

"ead. Examiner submits that opening and reading the article constitutes an expression of interest.

Claim 1 has been amended to with respect to the functions performed by the filtering module wo

further specify "...determining information about the user based on the user's historical access

pattern to particular products or policies and services the user in authorized to sell based at least

in part on an IP address associated with the user...".

With respect to these elements, both Cullen and Herz employ Internet Protocol addresses for

communicating messages to the user. Both references accordingly employ IP addressed

associated with the user. Herz et al., further discloses retrieving product and service

information/articles based on the identity of the user and a profile established for the user as a

result of passively monitoring the users access to information content (*see citations and

discussion above). Herz et al. further disclose that the (Herz et al.; col. 32, lines 25-55 *see proxy

server identifies user by address on the server, i.e., "IP address")

Neither Cullen nor Herz specify that the retrieved products are product the "authorized to

sell...".

Regarding filtering information in accordance with defining products the "user is authorized to sell"., as evidenced by Jinnett, it is well known in the e-commerce, insurance, and financial service art(s) to tailor or customize insurance and financial product information to such that it is in compliance with regulatory constraints that dictate the products that are authorized to be sold by a user or to a user in the user's respective jurisdiction, (Jinnett; Abstract paragraphs [0025] [0038] [0103]-[0109]). Specifically, Jinnett disclose a system and method that presents insurance and financial service product information and customizes transactions to accommodate the jurisdiction of the user, i.e., "products the user is authorized to sell", (Jinnett; paragraphs [0018] [0045] [0051] [0106]0[0108]).

Jinnett further discloses an administrative module/interface for inputting, updating and accessing user and product information (Jinnett; paragraphs [0099] [0103] [0109] *see updating and maintaining databases including products and user authentications, i.e., product information and user information).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the manual entry of user profile/preferences information of Cullen et al. with the filtering/access pattern-based profile of Herz et al. with the motivation and reasonable expectation of successfully directing subsequent queries to products and services that are relevant to the user's interests without requiring the user to expend an excessive amount of time and energy searching for the information (Herz et al.; col. 1, lines 46-50 and col. 8, lines 1-7).

Further, it would have been obvious to one of ordinary skill in the art to have modified the

particular preference settings and interest-based filtering of Cullen to customize deliverables

(i.e., product and service information) to accommodate the legal/regulatory standards of the

desired location (Jinnett; paragraph [0107]) with motivation and reasonable expectation of

successfully ensuring that products offerings are made and transactions are conducted without

violating the laws of the applicable jurisdiction (Jinnett; Abstract).

As per claim 2, Cullen et al. teach a system wherein the insurance or financial services-related

content is delivered to the user over the communications network (Cullen et al.; col. 1, lines 61-

67, col. 3, lines 2-9, and col. 6, lines 9-21).

As per claim 4, Herz et al. teaches a system wherein the insurance or financial services-related

content delivered to the user is located at a URL address (Herz et al.; col. 38, lines 18-32 and col.

58, lines 26-56).

As per claim 5, Herz et al. teach a system wherein the insurance or financial services-related

content is delivered to the user via mail delivery means (Herz et al.; col. 38, lines 18-32, and col.

58, lines 26-56).

As per claim 6, Herz et al. teach a system wherein the mail delivery means comprises the United

States Postal Service (Herz et al.; col. 38, lines 18-32, and col. 58, lines 26-56 NOTE: Examiner

considers the use United States Postal Service "USPS" to be a user choice).

As per claim 7, Herz et al. teach a system wherein the mail delivery means comprises express

delivery service (Herz et al.; col. 38, lines 18-32, and col. 58, lines 26-56 *express mail is a user

choice).

As per claim 9, Cullen et al. teach a system wherein the information about the user and the

insurance or financial services-related content are stored in a database (Cullen et al.; col. 3, lines

10-15, col. 6, lines 32-34 and col. 7, lines 42-44).

As per claim 10, Cullen et al. teach a system wherein the information about the user comprises

the user's identity (Cullen et al.; col. 3, line 42 and col. 5, lines 33-41).

As per claim 11, Cullen et al. teach a system wherein the information about the user comprises

log-in information such as user name and password (Cullen et al.; col. 4, lines 1-34).

As per claim 12, Cullen et al. teach a system wherein the insurance or financial services-related

content comprises information about insurance products and services available to the user

(Cullen et al.; col. 3, lines 10-15 and col. 7, lines 13-15).

As per claim 13, Cullen et al. teach a system wherein the insurance or financial services-related

content comprises literature about insurance products and services available to the user

(Cullen et al.; col. 6, lines 9-21).

As per claim 14, Cullen et al. teach a system wherein the communications network comprises the

Internet (Cullen et al.; col. 3, lines 2-9).

Regarding claims 2, 4-7, and 9-14, the statements of obviousness and motivation to combine as

discussed with regard to claim 1 above are applicable to claims 2, 4-7, and 9-14 and are herein

incorporated by reference.

Claim 15 substantially repeats the subject matter of claim 1. Accordingly, claim 15 as presently

amended is rejected as obvious in consideration of Cullen et al., in view of Herz et al. and further

in view of Jinnett for the reasons, conclusions of obviousness, and statements motivation as

discussed above with respect to claim 1.

As per claim 16, Cullen et al. teach a method wherein the insurance or financial services-related

content is delivered to the user over the communications network (Cullen et al.; col. 1, lines 61-

67, col. 3, lines 2-9, and col. 6, lines 9-21).

As per claim 17, Herz et al. disclose a method wherein the insurance or financial services-related content is delivered to the user via mail delivery means (Herz et al.; col. 38, lines 18-32 and col. 58, lines 26-56).

As per claim 18, Herz et al. disclose a method wherein delivering the insurance or financial services-related content comprises transferring the user to a URL address containing the insurance or financial services-related content (Herz et al.; col. 38, lines 18-32 and col. 58, lines 26-56).

As per claim 19, Cullen et al. teach a method wherein the information about the user comprises the user's identity (Cullen et al.; col. 3, line 42, and col. 5, lines 33-41).

As per claim 20, Cullen et al. teach a method wherein the user's identity is automatically determined upon the user accessing the filter module (Cullen et al.; col. 3, line 42, and col. 5, lines 33-41 and col. 4, lines 1-24).

As per claim 21, Cullen et al. teach a method where the user's identity is determined based on the user's username and password (Cullen et al.; col. 4, lines 1-35).

Claim 22 has been cancelled.

As per claim 23, Cullen et al. teach a method wherein the insurance or financial services-related content comprises literature relating to products and services available to the user (Cullen et al.; col. 6, lines 9-21).

As per claim 24, Cullen et al. teach a method wherein the information about the user is stored in a database (Cullen et al.; col. 6, lines 32-34 and col. 7, lines 42-44).

Regarding claims 16-21 and 23-24, the statements of obviousness and motivation to combine as discussed with regard to claim(s) 15/1 above are applicable to claims 16-21 and 23-24 and are herein incorporated by reference.

Claim 25 substantially repeats the subject matter of claim 1 and has been amended to include the subject matter presented by claim 1. Accordingly, claim 25 as presently amended is rejected as obvious in consideration of Cullen et al., in view of Herz et al. and further in view of Jinnett for the reasons, conclusions of obviousness, and statements motivation as discussed above with respect to claim 1.

As per claim 26, Cullen et al. teaches a method wherein the insurance or financial services-related content is received over the communications network (Cullen et al.; col. 1, lines 61-67 and col. 3, lines 2-9 and col. 6, lines 9-21).

As per claim 27, Cullen disclose a method wherein the insurance or financial services-related

content is received via mail delivery means (Cullen et al.; col. 1, lines 61-67 and col. 3, lines 2-9

and col. 6, lines 9-21 NOTE: see "address").

As per claim 28, Cullen et al. teaches a method wherein the insurance or financial services-

related content comprises information about insurance products and services available to the user

(Cullen et al.; col. 3, line 10-15, and col. 7, lines 13-15).

Regarding claims 26-28, the obviousness and motivation to combine as discussed with regard to

claim 25 above are applicable to claims 26-28 and are herein incorporated by reference.

As per claim 30, Cullen and Herz fail to disclose a system wherein products and services the user

is authorized to sell is based at least in part on the user's location.

However, Jinnett discloses a system wherein products and service the user is authorized to sell is

based in part on the user's location (Jinnett; paragraphs [0018] [0045] [0051] [0106]0[0108]).

Regarding claim 30, the obviousness and motivation to combine as discussed with regard to

claim 1 above are applicable to claim 30 and are herein incorporated by reference.

[6]   Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cullen et al.,

Herz et al., and Jinnett, as applied to claim 1 above, and further in view of Quido et al.

As per claim 3, although Cullen et al., teach delivering insurance or financial services-related

content to a user via a computer network (Cullen et al.; Abstract), neither Cullen nor Jinnett, nor

Herz specifically teach transmitting content in PDF format.

However, Quido et al., teaches a system wherein the insurance or financial services-related

content is delivered in PDF format (Quido et al.; paragraphs [0095] [0101]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to have combined the teachings of Cullen et al., Herz et al., and Jinnett, as applied to claim 1

above, with those of Quido et al. Such combination would have resulted in a system and method

in which a mobile software agent obtains the details of a user's requirements, obtains financial

information from the server computers on behalf of the user in light of the users requirements,

and then delivers the financial information to the user (Cullen et al.; Abstract). The motivation to

combine the teachings would have been store content in PDF format, a format that is well known

in the art as evidenced by Quido et al., such that the documents could be made available to an

online user (Quido et al.; paragraph [0095]).

[7]   Claims 8 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Cullen et al., Herz et al. and Jinnett as applied to claim 1 above, and further in view of Parker

(United States Patent Application Publication #2003/0182290).

As per claim 8, Cullen et al., Jinnett, and Herz et al. fail teach scanning documents into the

system.

However, scanning hardcopy documents for the purpose of computer storage is old and well

known in the art as is evidenced by Parker (Parker; paragraph [0023]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to have combined the teachings of Cullen et al., Herz et al., and Jinnett as applied to claim 1

above, with those of Parker. The motivation to combine the teachings would have been to

employ a technique that is old and well-known in the art for the purpose of converting written

documents into computer storable images (Parker; paragraph [0023]) such that scanned

document images such as insurance policies, wills, medical histories etc., can be stored on the

computer (Parker; paragraph [0023]).

Claim 29 differs from claim 1 with regard to the claimed administration module. Claim 29

further specifies the features of the claimed administration module to require "....wherein the

administration interface includes scanning means for uploading insurance or financial services-

related information". As per this element, Cullen et al., and Herz et al. fail to disclose and

administration interface including scanning means.

While Jinnett teach a system wherein the administration interface serves in the uploading of

insurance or financial services-related information, Jinnett fails to disclose scanning means for

scanning hardcopy documents into the system.

However, as evidenced by Parker, it is well-known in the art to use a scanner to scan documents

into electronic form such that they can be stored and accessed electronically (Parker; paragraph

[0023]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to have combined the teachings of Cullen et al., Jinnett., and Herz et al. as applied to claim 1

above, with those of Parker. It would have been obvious to have modified the interface of

Cullen et al. to include well-known technologies for converting written documents into computer

storable images (Parker; paragraph [0023]) with the motivation of enabling pertinent documents

such as insurance policies, wills, medical histories etc. to be converted to electronic images so

that they can be stored on the computer (Parker; paragraph [0023]).

Response to Remarks

[8]   Applicant's remarks filed 7 January 2011 have been fully considered and are persuasive.

The remarks will be addressed below in the order in which they appear in the noted response.

Applicant remarks that the amendment(s) to claims 1-14, 29, and 30 under 35 U.S.C. 101 are

moot as the noted rejection(s) have been withdrawn above.

Applicant remarks that in the Office Action mailed 7 October 2010, Examiner failed to address

the amended limitation of specify "…determining information about the user based on the user's

historical access pattern to particular products or policies and services the user in authorized to

sell based at least in part on an IP address associated with the user..." as presented in the

amendment filed 13 July 2010. In response, Examiner agrees and appreciates Applicant's

identification of the noted oversight. Examiner has addressed the noted amended limitation in the

present Office Action in the newly entered rejection under 35 U.S.C. 112, second paragraph and

in the rejection of the subject claims under 35 U.S.C. 103(a) above. This Office Action is made

non-final as a result of Examiner's omission.

Applicant provides further commentary regarding the features of "based at least in part on an IP address associated with the user...". Examiner notes that theses comments are addressed above in the context of the rejections under 35 U.S.C. 112, second paragraph and 35 U.S.C. 103(a) and directs Applicant's attention to the noted sections of the instant office action in response.

Applicant further remarks that Examiner fails to properly modify Cullen with the teachings of Jinnett. In response, Examiner directs Applicant's attention to the rejection of claim 1 under 35 U.S.C. 103(a) and notes that Examiner modifies the teachings of Cullen with "one or more references". Examiner maintains that the combination is proper.

Applicant's remaining remarks substantially rehashes arguments previously presented. In response, Examiner directs Applicant's attention to the preceding Office Actions in the mailed 13 April 2010, 15 September 2009 and 3 February 2009 incorporated by reference herein.

Conclusion

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to R. David Rines whose telephone number is (571)272-5585. The
examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the
organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
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information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. David Rines/
Primary Examiner, Art Unit 3623